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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,724	08/20/2003	Paul Edwin Jones	2705-283	1756
20575 7590 12/08/2009 MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204				
EXAMINER				
JUNTIMA, NITTAYA				
ART UNIT		PAPER NUMBER		
2462				
MAIL DATE		DELIVERY MODE		
12/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/645,724

**Applicant(s)**

JONES ET AL.

**Examiner**

NITTAYA JUNTIMA

**Art Unit**

2462

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-36, and 38-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the Amendment filed on 9/9/2009.
2. **Claims 1-11, 13-36, and 38-42** are pending (claims 12 and 37 were canceled).

#### *Claim Objections*

3. **Claims 5** are objected to because of the following informalities:  
  
- in claim 5, line 4, "one of" should be changed to "either" to put the claim in a better form;  
  
Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-4, 21-36, and 38-42** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**In claim 1**, the claim recites that **the delay point indicating call supplementary services**, the call supplemental services including one of call completion on busy and call completion on no answer which was not described in the original specification. Note that the

specification only discloses a delay point that indicates an explicit notification that the called endpoint is not busy (page 10, lines 7-11, page 7, lines 18-21) to support call delay establishment in conjunction with CCBS (pages 5, lines 4-19 and page 10, lines 7-23), not call supplemental services themselves. In other words, there is a support for using delay call establishment to provide call supplemental services including one of call completion on busy and call completion on no answer, but there is *no* support/teaching on indicating call supplemental services as a delay point. Therefore, the limitation the delay point indicating call supplementary services constitutes new matter.

**In claims 21 and 26**, similar to claim 1, the claims recite that **call request message including (i) feature discovery of a called endpoint and (ii) call supplementary services** which was not described in the original specification. Regarding (i), although the specification discloses delaying the establishment of a call until feature discovery process is complete (page 1, lines 19-24 and page 4, lines 21-page 5, lines 1-3, see also claim 20 for claiming feature discovery as a process) and DPI value 1 for “Terminal Capabilities are received by the called endpoint” (see table for possible delay point to be included in the call request on page 7), the specification does not disclose that the call request message includes feature discovery of a called endpoint which is a process of determining if features of the called endpoint match features of the calling endpoint. Regarding (ii), note that the specification only discloses a delay point (included in the call request) that indicates an explicit notification that the called endpoint is not busy (page 10, lines 7-11, page 7, lines 2-9 and 18-21) to support call delay establishment in conjunction with CCBS which is one of the call supplemental services (pages 5, lines 4-19 and page 10, lines 7-23), not call supplemental services themselves. In other words, there is a

support for using delay call establishment to provide call supplemental services including one of call completion on busy and call completion on no answer, but there is *no* support/teaching on including call supplemental services in the call request message. Therefore, the limitation call request message including (i) feature discovery of a called endpoint and (ii) call supplementary services constitutes new matter.

**In claims 31, 35, and 36**, similar to claim 21, the claim recites that **the call request message including (i) feature discovery of a called endpoint**. However, the specification does not disclose that the call request message includes feature discovery which is a process of determining if features of the called endpoint match features of the calling endpoint as defined in the specification (page 1, lines 19-24). The specification only discloses delaying the establishment of a call until feature discovery process is complete (page 1, lines 19-24 and page 4, lines 21-page 5, lines 1-3, see also claim 20 for claiming feature discovery as a process) and DPI value 1 for “Terminal Capabilities are received by the called endpoint” (see table for possible delay point to be included in the call request on page 7). Therefore, the limitation the call request message including (i) feature discovery of a called endpoint constitutes a new matter.

**In claim 42**, similar to claim 21, the specification does not disclose call completion on busy and call completion on no answer in the call request message which is a new matter.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**6. Claims 5-8, 10, and 13-19** are rejected under 35 U.S.C. 102(e) as being anticipated by Riikonen (US 2004/0162094 A1).

**Regarding claim 5**, Riikonen teaches a method of delaying call establishment, the method comprising:

Transmitting, from a network device at a calling endpoint (caller terminal, Fig. 2), a call request message (INVITE F1) associated with a call to a called endpoint (callee terminal), the call request message including a delayed call establishment capability advertisement that is one of desired or mandatory (since a format or function of the delayed call establishment capability advertisement is not further defined, the delayed call establishment capability advertisement reads on a "SynchronizeLoading" header which inherently serves as an advertisement to the callee that the caller terminal in Fig. 2 supports a mandatory delayed call establishment) and a delay point indicating a point to which the call is to progress before delaying establishment of the call (the downloading and presentation of the multimedia content which must be complete by the callee terminal before starting the multimedia session in F10 of Fig. 2, as indicated in a form of a URL of the multimedia content in a new header Synchronize-Loading of the SIP INVITE message shown in Fig. 3). See paragraphs 0014, 0024-0025, and 0027.

**Regarding claim 6**, Riikonen teaches receiving a notification from the called endpoint that the delay point has been reached (the 180 ringing message is sent from the callee terminal to

the caller terminal after the downloading and presentation of the multimedia content is complete, Fig. 2 and paragraph 0027).

**Regarding claim 7**, Riikonen teaches determining if the call is to be established (the caller terminal must determine that the multimedia session in F10 is to be established before transmitting to the callee terminal an ACK message F9 and starting the multimedia session in F10, Fig. 2 and paragraph 002).

**Regarding claim 8**, Riikonen further teaches notifying the called endpoint if the call is to be established (since the order of the notifying step is not further defined, therefore, the notifying step reads on sending of a SIP INVITE message from caller terminal to callee terminal, paragraph 0027).

**Regarding claim 10**, Riikonen further teaches transmitting a call request message comprising transmitting a session initiation protocol INVITE message (a SIP INVITE message F1 in Fig. 2, paragraph 0024).

**Regarding claim 13**, Riikonen teaches receiving a notification from the called endpoint (callee terminal) comprising a Delay Point Reached message (the 180 ringing message F7 in Fig. 2 is used to notify the caller that the downloading and presentation is complete, paragraph 0027).

**Regarding claim 14**, Riikonen also teaches sending a Delayed Call Establishment Release message to notify the called endpoint to alert a called user, thereby establishing the call (the order, structure or function of a Delayed Call Establishment Release message is not further defined, therefore, the step of sending a Delayed Call Establishment Release message reads on sending a SIP INVITE message with Synchronize-Loading header from a caller terminal to a callee terminal shown in Fig. 2 to notify the callee terminal to alert a called user after a completion of the downloading and presentation, paragraph 0027).

**Regarding claim 15**, as shown in Fig. 2, Riikonen teaches a method of delayed call establishment, the method comprising:

Receiving, at a network device at a called endpoint (callee terminal, Fig. 2), a call request message (INVITE in F1) associated with a call indicating a need for delayed call establishment and identifying a delay point (the downloading and presentation of the multimedia content, which must be complete by the callee terminal before starting the multimedia session in F10 of Fig. 2, as indicated in a form of a URL of the multimedia content in a new header Synchronize-Loading of the SIP INVITE message as shown in Fig. 3), the call request message including a delayed call establishment capability advertisement that is one of mandatory or desired (since a format or function of the delayed call establishment capability advertisement is not further defined, the delayed call establishment capability advertisement reads on a “SynchronizeLoading” header which inherently serves as an advertisement to the callee that the caller terminal, Fig. 2 supports a mandatory delayed call establishment), the delay point indicating a point to which the call is to progress before delaying establishment of the call (the downloading and presentation of the multimedia content which must be complete by the callee



terminal before starting the multimedia session in F10 of Fig. 2, as indicated in a form of a URL of the multimedia content in a new header Synchronize-Loading of the SIP INVITE message shown in Fig. 3). See paragraphs 0014, 0024-0025, and 0027.

**Regarding claim 16**, Riikonen teaches transmitting a response indicating availability of delayed call establishment and progressing the call to the delay point (a 183 session progress message in F4 is sent from the callee terminal to the caller terminal and download process begins in F5, Fig. 2 and paragraphs 0025-0026).

**Regarding claim 17**, Riikonen teaches notifying a calling endpoint that the delay point has been reached (the 180 ringing message is sent from the callee terminal to the caller terminal after the downloading and presentation of the multimedia content is complete, Fig. 2 and paragraph 0027).

**Regarding claim 18**, Riikonen teaches processing the call as indicated by the calling endpoint (Fig. 2 and paragraphs 0025-0028).

**Regarding claim 19**, Riikonen also teaches processing the call which comprises alerting a use, of the called endpoint, of the call (paragraph 0027).

7. **Claims 5-10, 13, 15, and 17-20** are rejected under 35 U.S.C. 102(c) as being anticipated by Donovan (US 6,366,577 B1).

**Regarding claim 5**, as shown in Figs. 2 and 3, Donovan teaches a method of delaying call establishment, the method comprising:

Transmitting, from a network device (SIP1 150 in Figs. 1 and 2) at a calling endpoint (115, 120, collectively, in Fig. 1 constitute a calling endpoint), a call request message (SIP INVITE message 6, Fig. 2 requesting QoS sent from SIP1 150 to SIP2 152) associated with a call to a called endpoint (121, 101, and 111, collectively, in Fig. 1 constitute a called endpoint). the call request message including a delayed call establishment capability advertisement that is either desired or mandatory and a delay point indicating a point to which the call is to progress before delaying establishment of the call (neither specific format nor function of the advertisement is defined, therefore, the delayed call establishment capability advertisement and a delay point reads on the QoS in the SIP INVITE message 6, Fig. 2 which inherently advertises to the SIP2 152 in Fig. 2 that SIP1 150 supports mandatory end-to-end QoS assurance before ringing the called party -- SIP1 150 requesting QoS which preventing the called telephone from ringing until policy ensuring the QoS has been provisioned and resources have been reserved end-to-end, col. 4, lines 15-21, 34-39, col. 6, lines 63-65 and col. 7, lines 15-55).

**Regarding claims 6 and 13**, Donovan teaches receiving a notification comprising a Delay Point Reached message from the called endpoint that the delay point has been reached (a Delay Point Reached message reads on a RESV-CONF message 40 in Fig. 3 which indicates completion of LAN QoS reservation end-to-end and inherent completion of policy provisioning

in Fig. 2, col. 8, lines 17-23; see also col. 4, lines 35-39; note that the claim does not specify who performs the receiving step).

**Regarding claim 7**, Donovan teaches determining if the call is to be established (prior to SIP phone 115 requests call setup by sending INVITE message 1 in Fig. 2, it has to determine if the call is to be established, col. 6, lines 28-29; note that the claim does not specify who performs the determining step).

**Regarding claim 8**, Donovan also teaches notifying the called endpoint if the call is to be established (a SIP INVITE message 6 in Fig. 2 serves a notification to SIP 152 which is part of the called endpoint when the call is to be established with QoS, col. 6, lines 63-65; note that the claim does not specify who performs the notifying step).

**Regarding claim 9**, Donovan also teaches performing maintenance testing without notifying the called endpoint to start alerting a called user, wherein maintenance comprises service level verification (Fig. 2 shows that SIP1 152 sends a COPS REQ AAA message 7 to verify the QoS policy for user, col. 4, lines 15-39, col. 5, lines 22-24, col. 6, lines 65-67).

**Regarding claim 10**, Donovan teaches transmitting a call request message comprising transmitting a SIP INVITE message (col. 6, lines 63-65).

**Regarding claim 15**, as shown in Figs. 2 and 3, Donovan teaches a method of delaying

call establishment, the method comprising:

Receiving, at a network device (152 in Fig. 2) at a called endpoint (121, 101, and 111, collectively, in Fig. 1 constitute a called endpoint), a call request message (SIP INVITE message 6, Fig. 2 requesting QoS sent from SIP1 150 to SIP2 152) associated with a call indicating a need for delayed call establishment and identifying a delay point (SIP1 150 requesting QoS which preventing the called telephone from ringing until policy ensuring the QoS has been provisioned and resources have been reserved end-to-end), the call request message including a delayed call establishment capability advertisement that is either desired or mandatory (neither specific format nor function of the advertisement is defined, therefore, the delayed call establishment capability advertisement and a delay point reads on the QoS in the SIP INVITE message 6, Fig. 2 which inherently advertises to the SIP2 152 in Fig. 2 that SIP1 150 supports mandatory end-to-end QoS assurance before ringing the called party), the delay point indicating a point to which the call is to progress before delaying establishment of the call (Requested QoS prevents the called telephone from ringing until policy ensuring the QoS has been provisioned and resources have been reserved end-to-end). See col. 4, lines 15-21, 34-39, col. 6, lines 63-65 and col. 7, lines 15-55.

**Regarding claim 17**, Donovan teaches notifying a calling endpoint (115 in Fig. 3 is part of calling endpoint 115 and 120 in Fig. 1, collectively) that delay point has been reached (a RESV-CONF message 40 in Fig. 3 indicating completion of LAN QoS reservation end-to-end and inherent completion of policy provisioning in Fig. 2, col. 8, lines 17-23; see also col. 4, lines 35-39).

**Regarding claim 18**, Donovan teaches processing the call as indicated by the calling endpoint (Figs. 2 and 3 show that the call is processed by provisioning the policy and reserving resources end-to-end to ensure an acceptable level of QoS as indicated by SIP1 150 which is part of the calling endpoint 115 and 120 in Fig. 1, collectively, col. 4, lines 15-20, 35-39, col. 6, lines 22-col. 7, lines 55).

**Regarding claim 19**, Donovan teaches alerting a user, of a called endpoint, of the call (ringing, col. 7, lines 50-55).

**Regarding claim 20**, Donovan teaches performing maintenance (service level verification (Fig. 2 shows that SIP1 152 sends a COPS REQ AAA message 7 to verify the QoS policy for user, col. 4, lines 15-39, col. 5, lines 22-24, col. 6, lines 65-67) and feature discovery (SIP INVITE message 6 sent by SIP1 150 in Fig. 2 requesting QoS, therefore, during QoS setup, it must be determined if both calling and called endpoints have matching resources to provide the required QoS end-to-end) on the called endpoint without alerting a user of the called endpoint, in which feature discovery comprises determining if the calling endpoint and the called endpoint have matching features (Figs. 2 and 3, col. 6, lines 34-45, 63-65, col. 7, lines 31-55).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Riikonen (US 2004/0162094 A1).

**Regarding claim 11**, Riikonen fails to explicitly teach the step of transmitting a call request message comprising transmitting an H.323 Setup message. An official notice is taken that it is well known in the art that a Setup message of H.323 protocol is equivalent to an INVITE message of SIP protocol and H.323 protocol is widely used as a protocol for setting connection/session as an alternative to the SIP protocol. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the teaching of Riikonen to include transmitting an H.323 Setup message as claimed. The suggestion/motivation to do so would have been to utilize H.323 protocol as an alternative to SIP in order to support H.323 devices, and such modification involves only routine skills in the art.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NITTAYA JUNTIMA whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 9:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nittaya Juntima/  
Primary Examiner, Art Unit 2462  
12/7/2009